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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/634,255 04/18/96 OHKUMA

N 35-C11365

EXAMINER

005514 MMC2/0116  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK NY 10112

BRIEF UNIT, M

PAPER NUMBER

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01/16/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/634,255	OHKUMA ET AL.
	Examiner Michael S. Brooke	Art Unit 2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 October 2000.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2 and 4-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkuma et al. (U.S. 5,478,606) in view of Field et al. (U.S. 3,852,222).

Ohkuma et al. discloses a liquid jet recording head which includes a member formed from a cured product of a resin composition comprising an epoxy and a photopolymerization initiator which acts to cure the epoxy (see column 5, lines 35-60). The resin composition which includes a compound which contains a functional group which reacts with the curable epoxy, as well as a fluorocarbon moiety, is subjected to cationic polymerization and (see column 5, lines 61-68 and column 6, lines 4-6). Note: Although the reference does not specifically disclose that this compound contains a reactive "functional group" this group is inherently disclosed since the reference does disclose that this compound "reacts" with the curable epoxy which in most cases involves a functional group (see column 6, lines 1-6). Tables I and 2 teach various concentrations of the compound having a functional group and fluorocarbon moiety. In addition, the compound which contains a fluorocarbon moiety (see column 6, line 6) contains fluorine at an amount of -30% which is well within the range specified. A curing

agent is also disclosed in column 5, lines 55-60. Further, the curable epoxy compound is an aromatic epoxy compound such as bisphenol A (see column 5, lines 35-36). The curable epoxy compound disclosed also includes an alicyclic epoxy compound which is an epoxy compound having an oxycyclohexane skeleton (see column 5, lines 35-42).

The reference also discloses a method of making the liquid jet recording head which entails forming an ink flow path pattern from a soluble resin on an ink discharge pressure-generating element on a base plate, forming a coating resin layer on the soluble resin layer, removing of the soluble resin layer by elution, and forming a discharge opening through the coating resin layer (see column 2, lines 28-42). In addition, the reference discloses that the method of forming the discharge opening is accomplished by the well known technique of photolithography (see column 4, lines 28-32). Finally, it is well known in the art to form discharge openings by either oxygen plasma etching or excimer laser irradiation. In any event, Ohkuma et al. discloses in column 7, lines 29-30 that the discharge openings can be formed by either of these methods.

Ohkuma et al. discloses the claimed invention except for the functional group which reacts with the curable epoxy being a hydroxyl group, where the compound having a functional group has the structure of an aromatic or alkyl fluorinated diol.

Field et al. teaches that it is known to use aromatic and alkyl diols which contain hydroxyl functional groups as compounds useful for polymerization reactions as set forth in column 2, lines 13-20.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use aromatic and alkyl diols which contain hydroxyl functional groups as the compound which reacted with the curable epoxy of Ohkuma et al. as taught by Field et al. in order to provide a polymeric coating to the liquid jet recording head which is highly hydrophobic and therefore extends the life of the liquid jet recording head. Finally, although neither Ohkuma et al. or Field et al. teach the specific concentration (i.e., 5-50%) of the compound having a functional group and fluorocarbon moiety, both Ohkuma et al. (in Tables I and 2) and Field et al. (in Examples I and 11) teach various concentrations of this compound. In addition, in a polymerization reaction involving functional groups such as hydroxyl groups, the weight of the compound having functional groups is irrelevant, since the reactivity of the compound having functional groups is based on the stoichiometric ratio of the hydroxyl groups on the molecule, so that a molecule that has many hydroxyl groups can be used at a lower weight percent than a molecule having few hydroxyl groups. Therefore, in the absence of any showing of criticality for this claimed range, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize routine optimization when selecting the weight of the compound having a functional group of Ohkuma et al., for the purpose of optimizing the stoichiometric or molar ratios of that compound in the polymerization reaction.

### ***Conclusion***

3. This is a CPA of applicant's earlier Application No. 08/634,255. All claims are drawn to the same invention claimed in the earlier application and could have been

finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael S. Brooke whose telephone number is 703-305-0262. The examiner can normally be reached on 6:30-300 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow can be reached on 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

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Art Unit: 2853

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Michael S. Brooke  
January 11, 2001

  
John Barlow  
Supervisory Patent Examiner  
Technology Center 2800